



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/471,890	06/07/1995	DONALD R. HUFFMAN	7913ZY	9010

7590 12/14/2006

LEOPOLD PRESSER
SCULLY SCOTT MURPHY & PRESSER
400 GARDEN CITY PLAZA
GARDEN CITY, NY 11530

EXAMINER

HENDRICKSON, STUART L

ART UNIT	PAPER NUMBER
----------	--------------

1754

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 08/471,890		Applicant(s) HUFFMAN ET AL.	
Examiner Stuart Hendrickson		Art Unit 1754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 89-93 and 95-121 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 89-93 and 95-121 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1754

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. The request under 129(a) is accepted.

Claims 89, 93, 95, 96, 107 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

A) Claims 89 and 93 recite 'macroscopic' amounts of the material, but the original specification does not support this. The discussion on pgs. 5-8 of the prior office action (6/3/96) are referred to and incorporated.

Claims 90-92 and 95-121 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kroto/Nature November 14, 1985, with the Curl/Scientific American cited to show a state of fact.

Applicant is referred to the office action of 6/3/96, incorporated herein by reference. The additional claims are sufficiently similar to the claims previously rejected that no separate discussion thereof is necessary. It is noted that product-by-process claims are product claims and it is not necessary for the PTO to show the same process.

Applicant's arguments filed ca. 5/9/06 have been fully considered but they are not persuasive. Prior arguments are incorporated herein by reference. Concerning macroscopic, the Board has ruled that this is not supported (if only because it is not defined) in prior proceedings, incorporated herein by reference. Most of the arguments appear to be repetition of previous arguments, and/or are drawn to this issue. Hence no further counter-argument is offered herein. On pg. 19 it is argued that the fullerenes were 'observed'. However, this term does not necessarily mean visual observation; it may refer to electron micrographs, etc. The Kroto article uses the term 'observed' in column 1. Concerning the term 'fullerenes', the choice of words used in a PTO rejection/action does not impart any limitation or special status to the claims. The

Art Unit: 1754

observation of color meaning that particles are observed is not correct; one does not see particles in a rainbow or in the colored sparkle of a diamond. In the case of a solution, an adsorption is observed, just as adding a pH indicator which turns red in acid does not mean that suddenly the molecules of the indicator are visible. The argument that Kroto did not make enough to see, smell, touch (pg. 31), is too literal an interpretation; the applicant did not make enough to smell, touch or 'see' with the naked eye notwithstanding the broad interpretation of 'visible' which has been argued. No difference in the amount produced/isolated has been *demonstrated*.

It is noted that 'allotrope' is misspelled in the newly-added claims. It appears that claim 114 should depend from claim 113. The newly added product by process claims are taken to require the crystalline form, or amounts recited in the process part of the claims. As such, even though the preamble appears to be drawn to a naturally occurring product, the process steps are taken as requiring product characteristics which exclude this.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (703) 308-2539.



Stuart Hendrickson
Primary examiner Art Unit 1754